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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,070	04/04/2001	Jeffrey D. Messerly	END-0736	4524

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EXAMINER

ROBERTS, PAUL A

ART UNIT PAPER NUMBER

3731

11

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,070

Applicant(s)

MESSERLY, JEFFREY D.

Examiner

Paul A Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 21-24, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Huitema US 6117152.
2. Regarding 21, Huitema discloses a waveguide 50 comprising a blade 56 a distal portion (right side of the notch 59) and a proximal portion left side of the notch, a curved treatment portion (1, see attached sheet). A functional asymmetry is labeled (59). Claims 21 and 23 are rejected under different interpretations of figure 3. The first attached figure is relevant to claims 21 and 22, while the second attached figure (on same sheet) is relevant to claim 23.
3. Regarding claim 22, the functional asymmetry extends from the distal tip (2) of the blade to a point inside the treatment portion.
4. Regarding claim 23, the second attached diagram shows the new relationship between the functional asymmetry (3), distal end of the blade (57), and the treatment portion (4).
5. Regarding claim 24, a handle 30 is disclosed.
6. Regarding claims 27 and 28, the functional asymmetry is a spherical cut.
7. Claims 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Beaupre US 6283981.

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8. Regarding claim 21, Beaupre discloses a waveguide (figure 2) comprising a blade (28 and 26) with a distal and proximal end, a treatment portion (26) comprising a functional asymmetry (32 and 37). The purpose of the functional asymmetry is to counter torque create by the curve near 37 (col. 2, 35-60).

9. Regarding claims 22 and 23, the balance portion extends from the distal end of the blade to a point inside the treatment portion. A point inside the treatment portion is proximal to the treatment portion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaupre '981 in view of Huitema 6117152. Beaupre discloses all the elements of the waveguide and blade in claim 24 but does not disclose that the instrument contains a handle. However, ultrasonic tools need a location for the operator to hold, a handle. Huitema discloses a handle 30. At the time of the invention it would have been obvious to one of ordinary skill in the art to add a handle to the Beaupre device so a user could grab the tool.

11. Regarding claim 25, the Beaupre method is concerned with minimizing transverse vibrations. Beaupre states that it is the object of his invention to balance the blade to minimize transverse vibrations (35-40, col. 1).

Response to Arguments

12. Arguments regarding 35 USC 112 (2nd) claims 21-26: in view of the arguments on page 7 of the applicant's response, the blade will be considered the entire metal structure of figure 23 including elements 179 and 88. Additionally, the change in the claim language regarding the lack of support for the balance portion renders the scope of the claim clear. The rejection of claims 21-26 is hereby withdrawn, but it would be clearer if the applicant indicates in the drawings that the blade comprises the entire structure including elements 179 and 88. It is suggested but not required that the applicant make this change in the drawings.

13. Arguments on page 9 of the applicant's response: as discussed above, the functional asymmetry (which is understood to be equivalent to the balance portion) was identified in the prior art. The applicant is arguing that the intended use of the structural element (in the Huitema device that the examiner labeled as the balance portion) is not intended to be used as a portion to counter torque created by the curved treatment portion. In response to applicant's arguments, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). That said, it is clear that the balance portion is inherently capable of being used to balance torque created by the curved segment, even though the prior art did not intend the balance portion to be used in this manner.

14. Page 10, first paragraph of the applicant's arguments: this argument is moot since the applicant has cancelled the language relevant to whether or not the blade is balanced.

15. Page 10, second and third paragraphs of the applicant's arguments: the applicant is suggesting the examiner used hindsight from the applicant's disclosure. Hindsight or lack thereof is not relevant to a rejection under 35 USC 102(e). The matter at hand is, does Huitema disclose (either explicitly or inherently) all the limitations of the applicant's claim. Why Huitema built his device to have a portion that meets the structural limitations of the applicant's claim, is not a patentable difference under 35 USC 102(e). The reason Huitema anticipates claim 21 is Huitema discloses all the structural limitations of the applicant's claim?

16. Pages 10 and 11 of the applicant's arguments: as shown in figure 1, the treatment section and balance portions are unitary in structure. The scope of a treatment section is simply a section on a tool capable of being used to treat a patient. The entire section 26 of figure 2 is capable of this feature and thus the limitations that the treatment region comprises a balance region is anticipated. Elements 32 and 37 change the center of gravity of the treatment section. This changes the balance of the treatment section. An element that changes the balance of the treatment section is within the scope of a treatment section comprising a balance portion.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Paul Roberts
April 14, 2004


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700